Response

Applicants, through their attorney, respectfully request the Examiner to consider the application in view of the included amendments and remarks. Entry of these remarks after final rejection, and consideration of this response, is requested because it is believed to put the claims in condition for allowance or, alternatively, to simplify issues for possible appeal.

Support

Applicants have amended claim 1 to specify that the organic solvent based functional fluid of the present invention is selected from the group consisting of lubricating oils, engine oils, transmission fluids, greases, gear oils, hydraulic fluids, farm tractor fluids, transformer fluids, fuels, diesel, gasoline, biofuels, and mixtures thereof. Support for this amendment comes from claim 15 and page 6, lines 3-8 of the specification.

Applicants have also amended claim 21 to specify that the indicator used in the present invention is selected from a specific group of indicators. Support for this amendment comes from claim 21 itself and also from page 8, line 15 to page 10, line 25 of the specification.

Claim 15 has been cancelled.

No other elements of the claims have been changed.

Remarks

The Examiner rejected claims 1-15 and 21 under 35 U.S.C. 102(b) as being anticipated by Becket (US 5,710,372). Applicants point out that the November 14, 2008 office action contains the first 102(b) rejection of claim 21, as claim 21 was previously rejected in the July 16, 2008 office action under only 35 U.S.C. 112, second paragraph, as being indefinite. Applicants further note that the Examiner has not provided any specific basis for the current rejection of claim 21 over Becket, but instead has stated the same basis for the current rejections that were presented in the previous office action, when claim 21 was not rejected under the reference. Applicants have not previously had an opportunity to respond to a 102(b) rejection of claim 21 as the present office action is the first to include one. Thus Applicants respectfully submit that the present office action should be a non-final office action as opposed to a final office action.

Regardless of the type of rejection, Applicants have amended the claims in order to better demonstrate their novelty and non-obviousness over Becket.

Applicants have amended claim 1 to specify that the organic based functional fluid used in the present invention is selected from the group consisting of lubricating oils, engine oils, transmission fluids, greases, gear oils, hydraulic fluids, farm tractor fluids, transformer fluids, fuels, diesel, gasoline, biofuels, and mixtures thereof. All of these fluid types are known in the art and are known to be organic fluids. None of these fluids could be described as aqueous fluids or as aqueous fluids with one or more organic components. Many of these fluids may contain small amounts of water picked up as a contaminant, but certainly not the extent that they would fall under the teachings of Becket.

Becket teaches a "method for measuring the concentration of a constituent of an aqueous fluid composition (e.g. aqueous machining fluid composition) and for measuring total alkalinity thereof" (see the Abstract of Becket). The reference goes on to specify what it means by aqueous machining fluid composition, as "a complex aqueous liquid applied to the interface between a tool and a workpiece during the shaping of the workpiece by physical means" (see col 1, lines 36-40 of Becket). The rest of the background section makes it clear that the fluids Becket is concerned with are metal working fluids, which are generally water/aqueous based fluids that may contain one or more additives, including organic materials, but which do not inherently change the character of the fluid as being aqueous based. The reference then says that other embodiments of its invention include those where the aqueous fluid "is an aqueous cleaning fluid composition, an aqueous plating bath composition, aqueous cooling fluid composition, aqueous based hydraulic fluid, aqueous processing fluids, aqueous etching fluids, aqueous quenching fluids, aqueous agricultural fluids, and aqueous grinding fluids" (see col 5, lines 12-19 of Becket). No where in the reference is there any teaching of anything other than an aqueous fluid of some type. The reference even states clearly that its invention is limited to aqueous fluid compositions (see col 11, lines 30-35 of Becket).

In addition Becket is limited to measuring the pH of the fluid in question in order to determine the concentration of a component of the fluid. A requirement for making a measurement of pH is that the fluid being tested is aqueous. This further demonstrates the limitations of the teachings of the reference and its focus on aqueous fluids.

In contrast, the present invention specifies that its organic solvent based functional fluid is selected from a list which includes engine oils and fuels. These fluids are well known in the art and are known to be non-aqueous fluids, such that the teachings of Becket do not apply to them. One skilled in the art, looking to arrive at the methods of the present invention, would not start with or use the teachings of Becket because of its focus on aqueous fluids. Various additives and components, including markers and indicators such as those used in the present invention, are often compatible with either organic fluids or aqueous fluids, but not both. Therefore, one skilled in the art would not look toward the teachings of a reference limited to aqueous fluids, and apply such teachings to organic fluid systems, or vice versa.

The present invention specifies the functional fluids to be used in its methods. None of these functional fluid types are disclosed or taught by the reference. As Becket fails to teach a required feature of the invention, Applicants respectfully submit that the present invention (specifically claims 1-14) is both novel and non-obvious over the reference and request that all current rejections based on Becket be removed.

With regards to claim 21, the indicator used in the methods of the present invention is specified in the claim.

Becket, at col 10, lines 8-23, lists the following indicators which may be used in its invention: methyl orange, bromophenol blue, 4,4'-bis (2 amino-1-naphthylazo- 2,2'-stilbenzdisulfonic acid, 2-(2,4-dinitrophenylazo)-1-naphthol-3, 6-disulfonic acid disodium salt, phenolphthalein, nitrazine yellow, bromocresol green, phenolsulfonephthalein, thymolsulfonephthalein and resorcin blue. Becket notes that this list is not meant to be limiting but Becket does not provide any other indicators which may be used or motivation toward finding and/or identifying other suitable indicators.

In contrast, the present invention, in claim 21, specifies a list of indicators which may be used in the present invention. None of these indicators are taught or disclosed in Becket. As Becket fails to teach a required feature of the invention, Applicants respectfully submit that the present invention (specifically claim 21) is both novel and non-obvious over the reference and request that all current rejections based on Becket be removed.

Conclusion

For the foregoing reasons it is submitted that the present claims are novel and unobvious over the cited reference, and in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding office action. Therefore an early and favorable reconsideration is respectfully requested. If the Examiner believes that only minor issues remain to be resolved, a telephone call to the Undersigned is suggested.

Any required fees or any deficiency or overpayment in fees should be charged or credited to deposit account 12-2275 (The Lubrizol Corporation).

Respectfully submitted,

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